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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,328	08/23/2001	Chris Scotto	426882000600	9977

29638 7590 08/11/2005

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/938,328	<b>Applicant(s)</b> SCOTTO ET AL.	
	<b>Examiner</b> Tan Dean D. Nguyen	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-20, in the reply filed on 5/3/2005 is acknowledged. Claim 21 is withdrawn.

### ***Response to Amendment***

2. The amendment filed 12/27/04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "said first stage approach including the steps of presenting an initial customer interface and gathering feedback" and "said second stage approach including the step of refining said customer interface based on said customer feedback". The examiner has scanned the specification for these 2 amended language but only found some discussion with respect to the second stage only.

Applicant is required to cancel the new matter in the reply to this Office Action or show the examiner support for these two amended language in the specification.

### ***Claim Rejections - 35 USC § 101***

1. **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

2. As an initial matter, the United States Constitution under Art. 1, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing

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for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

3. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions (3) include (1) "laws of nature", (2) "natural phenomena", and (3) "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149, F.3d 1368, 1998, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

4. Mere idea in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the

"progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

5. This "two-prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the *Freeman-Walter-Abele* test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175, USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

6. The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter is statutory, not on whether the product of the claimed subject matter is statutory, not on whether the prior art which the claimed subject matter purports to replace is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., but whether it "enhances" the operation of a machine. In *re Toma* at 857.

7. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court

found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co. at 1374*. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "whether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co. at 1377*. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system comprising (a) computer processor, ...etc., for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of

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Patent Appeals and Interferences (BPAI) in affirming a j101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

9. Thus the present basis for a 35 USC 101 inquiry is a 2-prong test:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

**10. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

11. As to the 2<sup>nd</sup>-prong test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, as to claim 1, the claimed invention appears to produce a result "refining said customer interface based on said customer feedback" which is accepted (i.e., useful, concrete and tangible).

12. As to the 1<sup>st</sup>-prong test, independent claim 1, and its dependent claims, 2-20, fail this test. Under this test, for a process claim to pass muster under the "technological arts" prong, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-20 have no connection to the technological arts. The recited steps of merely "(a) performing a 1<sup>st</sup> stage approach including the steps of (1) presenting an initial customer interface and (2) gathering customer feedback, and (b) refining the customer interface based on the customer feedback", does not apply, involve, use, or advance the technological arts in a non-trivial way since all of the recited steps can be performed in the mind of a person, or by

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use of a pencil and paper, then manually and physically refining interface. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts in a non-trivial way as explained above, claims 1-20 are deemed to be directed to non-statutory subject matter.

13. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating a computer network or electronic network into some of the steps; for example: "(a) performing a first stage approach using a computer network ...; b) refining the customer interface using a computer network. The other claims could be similarly amended to include a computer network or a computer, in a significant way, in at least some of the steps.

14. See also (1) In re Schrader, 22 F.3d 290, 30 USPQ2d 1455 (CCPA 1994), (2) In re Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557, (3) In re Waldbaum, 173 USPQ 430 (CCPA 1972), (4) In re Musgrave, 167 USPQ 280 (CCPA 1970), and (5) In re Johnston, 183 USPQ 172.

### ***Response to Arguments***

15. Applicant's arguments with respect to the rejection under 101 filed 12/27/04 have been fully considered but they are not persuasive. Applicant's comments with respect to the 2 cases cited, State Street Bank and AT& T Corp. are noted; however, as indicated in paragraph 8 above, State Street never addressed the other part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in State Street (i.e., a computerized system comprising (a) computer processor, ...etc., for



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determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test.

Similarly, in AT&T Corp's case, it involves the application of mathematical algorithms to those data to determine the value of the PIC indicator, and applies that value through switching and recording mechanisms to create a signal useful for filling purposes.

Therefore, there is an integration of the mathematical algorithm to a machine as a whole is applied in a "useful" manner. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a j101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

16. Thus the present basis for a 35 USC 101 inquiry is a 2-prong test:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

17. As to the 1<sup>st</sup>-prong test, independent claim 1, and its dependent claims, 2-20, fail this test. Under this test, for a process claim to pass muster under the "technological arts" prong, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-20 have no connection to the technological arts. The recited steps (or abstract ideas) of merely "(a) performing a 1<sup>st</sup> stage approach including the steps of (1) presenting an initial customer interface and (2) gathering customer feedback, and (b) refining the customer interface based on the customer feedback", does not apply, involve, use, or advance the technological arts in a non-trivial way since all of the recited steps (abstract ideas) can be performed in the

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mind of a person, or by use of a pencil and paper, then manually and physically refining interface. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts in a non-trivial way as explained above, claims 1-20 are deemed to be directed to non-statutory subject matter.

### ***Claim Objections***

3. Claims 2-20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how claims 2 and 3-20 further limits "said 1<sup>st</sup> stage approach including the steps of presenting an initial customer interface and gathering customer feedback". There are no discussion with respect to the customer interface nor customer feedback of claim 1(a) in dep. claims 2-20.

### ***Claim Rejections - 35 USC § 112***

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is vague and confused because there are not writing in a positive active state wherein the steps are in an active positive state to carry out the scope of the claimed invention. For example, in (b), "performing a second stage approach for at least one of maturing the business and guiding the business to an IPO" is vague and confused since it's not clear what is the exact step taken and how it's

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carried out. Claims 2-20 have been reviewed but it's not clear how these further clarify the steps of presenting an initial customer interface and gathering customer feedback in (a) of claim 1.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over ARTICLE 1998 (Big name .. Hub) in view of YOUNG et al (US Patent 6,915,270).**

**As for independent method claim 1**, ARTICLE 1998 fairly teaches a method for guiding a business after an initial funding state, comprising

- a) performing a 1<sup>st</sup> stage approach for launching the business, said 1<sup>st</sup> stage approach including the steps of overhauling the marketing of the product in the world,
- b) performing a 2<sup>nd</sup> stage approach for at least one of maturing the business and guiding the business to an initial public offering readiness state {see page 2, 1<sup>st</sup> full

paragraph). ARTICLE 1998 fairly teaches the claimed invention except for lacking of explaining concerning "overhauling marketing strategies".

In a customer relationship management business method which emphasize on marketing management/strategies, YOUNG et al fairly discloses the marketing strategies including product/service surveying and gathering customer feedback with respect to the product /service in order to build profitable customer relationship or capture and retain loyal customers in an Internet age {see col. 1, lines 15-40 (or col. 1:15-40), col. 14:40-67, Tables 1, 2 , 3, and 4}. It would have been obvious to modify the marketing strategies of ARTICLE 1998 by those of YOUNG et al to build profitable customer and profitable product/service.

As for dep. claims 2-20 (part of 1), these are merely marketing management parameters are fairly taught in YOUNG et al on Figs. 1-7, and Tables 1-5. Alternatively, the various adjustments of the marketing parameters vary with the type of product/service, funding environment, type of consumer/customer, etc., and the adjusting of these variables are within the skilled artisan as routine experimentation to determine optimum results. In re Aller, 105 USPQ 233.

No claims are allowed.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

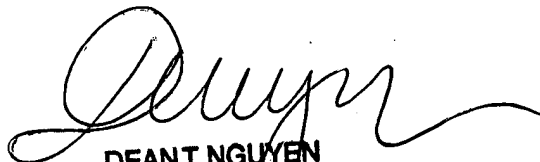
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
May 31, 2005

  
DEANT.NGUYEN  
PRIMARY EXAMINER

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